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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Horst Grafe et al.

SERIAL NO.: 09/710,390

FILED: November 9, 2000

FOR: High-Speed Shears for Transverse Cutting of a Rolled Strip

EXAMINER: Jason D. Prone

GROUP: 3724

Mail Stop **AMENDMENT**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION

Sir:

This is a response to the Office Action dated June 8, 2005.

Reconsideration of the application in view of the following remarks is respectfully requested.

The Examiner rejected Claims 23 under 35 U.S.C. §103 (a) as being unpatentable over Sieger, U.S. Patent No. 2,076,969 (Sieger'969) in view of Sieger, U.S. Patent No. 2,588,581 (Sieger'581), Martin, U.S. Patent No. 3,037,396 (Martin), and Sato et al., U.S. Patent No. 5,207,138 (Sato). It is respectfully submitted that claim 23 is patentable over the cited references.

Specifically, claim 23 recites:

an upper blade support formed as a beam bridge having a relatively large diameter and carrying a first blade and having a shaft stub on each of opposite longitudinal sides thereof; and

a lower blade drum having a comparatively small diameter and carrying a second blade.

The Office Action asserts that because Sieger'581 teaches that an upper blade support has a relatively large diameter and a lower drum support has a comparatively small diameter, it would have been obvious to provide the Sieger'969 with a larger upper blade support and a smaller lower blade support to allow the small drum to be placed inside the apparatus . . . (Office Action, the

paragraphs bridging pages 3 and 4). Applicant would like to point out that the object of Sieger'969 is to provide for shearing off precise lengths and has nothing to do with making the apparatus more compact. Neither is this an object of Sieger'581 nor of the present invention.

It is respectfully submitted that this assertion is not tenable.

Firstly, Sieger'581 teaches three drums (17, 16, 18) with both outside drums (17, 18) having a larger diameter than the middle drum (16), with the lowest drum (18) having even a greater diameter than the upper drum (17). Further, Siegers'581 has no disclosure whatsoever of replacement of the components.

Sieger'581 provides a plurality of drums with different diameters in order to provide a wide range of length into which a strip passing therethrough is to be cut, without necessitating the removal from or the addition of cutting elements to the rotary members (column 2, lines 1-5).

Further, such substitution would be contrary to express teaching of Sieger'969 that the lower carrier (drum) is designed so that it will engage the strip during a small portion of its revolution (page 1, lines 52-55, page 2, line 1), i.e., so that its diameter is greater than the diameter of the upper carrier.

Claim 23 also recites roller means (6, 6¹) for supporting the tensioned strip and providing for lifting of the strip before passing of the second lower blade and for lowering the strip before passing of the first upper blade through the blade gap. No such roller means is disclosed in any of the references. No such rollers are disclosed in Sato. Sato discloses pinch roller sets similar to the roller sets (4, 5) of this application. Supporting roller means, like rollers (6, 6¹) of the instant application are not disclosed in Sato. In Sato, it is the upper drum which is displaced to allow for passage of the strip (column 7, lines 21-51).

The combination of features set forth in claim 23 provides for high-speed shears that insure precise cutting of hot and/or cold strips, with the strip being transported with a high speed. It is respectfully submitted that the combination set forth in claim 23 would not be obvious in view of the prior art and would not be obvious over the combination of Sieger'969, Sieger'581, Martin, and Sato.

Under MPEP §2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP §2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” Id. At 1301.

No such evidence is presented in the Office Action. It is noted that the case law rejects the “common knowledge” of one skilled in the art as a substitute for specific evidence that the prior art suggests the invalidating combination of references. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the

art would have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. *In re Jones* 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992). No such evidence is presented in the Office Action. Such evidence should be based on the object of the invention and/or specific suggestions in the prior art.

Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such convincing line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that that teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Spinnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

It is respectfully submitted that obviousness of the present invention over the combination Sieger’981, Sieger’581, Martin, and Sato can be gleaned only from a hindsight reconstruction.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in Uniroyal v. Redkin-Willey, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a

subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

* * *

. . . it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

In Orthopedic Equipment Company, Inc. v. United States, 217

U.S.P.Q. 193-199 (Fed. Cir. 1983), the Federal Circuit warned:

The difficulty which attaches to all honest attempts to answer this question [of obviousness based upon a combination of prior art.] can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law

In view of the above, it is respectfully submitted that the combination of Sieger'969, Sieger'581, Martin, and Sato would be unobvious.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects, in order to place in case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

Alexander Zinchuk

Alexander Zinchuk, Reg. No. 30,541

Date: September 7, 2005
Abelman, Frayne & Schwab
666 Third Avenue, 10th Floor
New York, NY 10017-5621
212-885-9383

This correspondence is being deposited with the United States Postal Service on September 7, 2005 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number ER 843 204 970 US addressed to the Honorable Commissioner for Patents, Alexandria, VA 22313-1450.

Alexander Zinchuk
Alexander Zinchuk